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09/560,000	04/28/2000	Youji Kohda	1405.1022/JDH	3231

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DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2003* .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-12 and 14-22* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 10-12 and 14-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☒ All b)☐ Some * c)☐ None of:

   1.☒ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)		4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6)☐ Other: .

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9-12-03 have been fully considered but they are not persuasive:

1. The USC 112 rejection has been overcome by the amendment.

2. The applicant argues that the prior art does not teach receiving a status of a user of the mobile phone (amendment, page 11). The examiner disagrees – Sandegren teaches online notification for mobile "devices" in a mobile environment (title and abstract). If the "notification software" is loaded on a PC, mobile phone, laptop, etc., then that device can be notified. Hence a user can load the software on his laptop and phone and get notification message(s) at each device which reads on the claim.

3. The applicant argues claims 7-8 and 11-12 are not taught based on a user of the mobile terminal receives status of the user from another device. Firstly, the user must somehow enter/type-in their "status data", so this data is known and can be downloaded as required. As per #2 above, loading Sandegren's software on two different devices would provide status between the two devices (eg. the mobile phone would have the user's laptop as a device in it's notification list, see figure 1a, 1b and 1c) which reads on the claim.

4. For claims 6 and 10, Sandegren's notification applies to an application as well. The examiner notes that Sandegren can provide many different types of "status" (last sentence of Abstract) which reads on the claims.

5. The HLR/WOLN database provides authorization (as is known in the art for fraud deterrent, etc.). Hence the HLR/WOLN would provide for authorization based on the received mobile terminal user identification.

6. Claims 14-22 are rejected as per the Office Action below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-2 and 4-6 rejected under 35 U.S.C. 103(a) as being unpatentable over

Sandegren US 6,512,930 further in view of Gutfreund et al. US 6,192,394 (hereafter

Sandegren and Gutfreund).

As per **claims 1, 4**, Sandegren teaches an online notification method/system

(title) that provides status notification to users within the system (abstract – first

sentence), the method comprising steps of:

directly transmitting the status of the user from the first information terminal to a

mobile terminal of the user via an electronic information transmission medium to a

mobile terminal (abstract and C3, L45-55)

determining at the user mobile terminal whether the received status of the mobile

terminal user from the first information terminal is one of a plurality of user statuses

previously stored in the user mobile terminal (figures 1a-1c shows database of users)

transmitting the received user status in real-time from the user mobile terminal to

a predetermined second information terminal via a network according to the determining

(abstract and C3, L55-55-60); and

outputting at the second information terminal the received user status from the

user mobile terminal (abstract and C3, L64-66).

But is silent on determining status of a user using a first information terminal.

The examiner notes that a user must actually type-in/enter their status (or have it

determined by software), so the system will store the status which can be downloaded

to ANY user/device. Hence, if the user works at a laptop and has a list of

people/devices that are to be notified that INCLUDES the user's mobile phone, it will receive a status as well. Sandegren's invention will send status to ANY person/device on the "notify list" which means the user can add multiple devices that they own to the list which reads on the invention.

The applicant cites in their specification the ICQ notification system/device (Mirabilis, Ltd.) that allows a user to find out who are the other (arbitrary) users that are connected to the Internet (pg. 2, L1-15). **Gutfreund** teaches collaborative software that allows a user of the application to request a list of all (arbitrary) users known to the collaboration software (abstract).

***With further regard to claim 4, Sandegren* teaches identity (figures 1a-1c show a database of all identities in online notification application) and first/second terminals (figure 2c).**

It would have been obvious to one skilled in the art at the time of the invention to modify Sandegren, such that status can be determined, to provide means for the user to gather/transmit status to other people/devices on their notification list).

As per **claims 2/3**, Sandegren teaches claim 1 wherein the electronic transmission medium is an electronic wired/wireless communications channel (title teaches "wireless" which is an RF electronic communications channel AND figure 2a shows both wireless and wired communications links being used, #209 and #211/#215).

As per **claim 5**, Sandegren teaches claim 4, wherein
said generating device based on the status of the first information terminals prepare a status list listing each possible status of the user, select one of the user statuses from the status list and transmit both the status list and the selected user status to the mobile information terminal which transmits both the status list and the select user status to the second information terminal (figures 1b and 1c shows lists from each user's point of view) [C3, L16, C3, L45-66 and C3, L45-66].

As per **claim 6**, Sandegren teaches a <u>user status</u> generating device provided in an information terminal for running a predetermined application, comprising:

identification means for obtaining from the running application identification information for of a <u>user of the running application</u>;

decision means for determining a status of the user based on a status of the application; and

transmitting means <u>for</u> directly <u>connecting</u> with an external mobile terminal <u>of the user</u> through an electronic information transmission medium, and transmitting the user identification information and the user status to <u>external</u> mobile terminal <u>of the user</u> (Abstract, figures 1a thru 3e, C1, L65-67 to C2, L1-41 and C3, L45-66).

But is silent on <u>determining status of the user at first terminal.</u>

<u>The examiner notes that a user must actually type-in/enter their status (or have it determined by software), so the system will store the status which can be downloaded to ANY user/device. Hence, if the user works at a laptop and has a list of people/devices that are to be notified that INCLUDES the user's mobile phone, it will receive a status as well. Sandegren's invention will send status to ANY person/device on the "notify list" which means the user can add multiple devices that they own to the list which reads on the invention.</u>

The applicant cites in their specification the ICQ notification system/device (Mirabilis, Ltd.) that allows a user to find out who are the other (arbitrary) users that are connected to the Internet (pg. 2, L1-15). **Gutfreund** teaches collaborative software that allows a user of the application to request a list of all (arbitrary) users known to the collaboration software (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Sandegren, such that status can be determined from arbitrary users, to provide means for the user to gather status from other users within the network (other than those in his/her list).

Claims *7-8 and 10-13* rejected under 35 U.S.C. 103(a) as being unpatentable

over Sandegren/Gutfreund further in view of Daly et al US 6,393,014 (hereafter Daly).

As per **claims 7-8 and 10-13**, Sandegren teaches a mobile terminal transmitting

device in communication with a communicatin device connecting to a network device

and in real-time communication with external information terminals, comprising:

authorization means for authorizing the user of the mobile terminal based on

received mobile terminal identification information (HLR/WOLN database can provide

authorization means, C7, L34-47) and

transmitting means for transmitting the received mobile terminal user status via

communication device to the network device based on authorization (figure2a shows

wireless and wired transmitting means).

But is silent on receiving means for directly connecting in real-time with an

external information terminal and receiving means connectable directly to external

information terminals through an electronic information transmission medium, for

receiving the identification information and status of a user of the mobile terminal from

external information terminal.

With further regard to claim 8, Sandegren teaches storage means as shown in

figure 3d, #335 (ref. "updates his list" which implies storage in the phone).

Also reference Abstract, figures 1a thru 3e, C1, L65-67 to C2, L1-41 and C3, L45-66.

With further regard to claims 10-12, Sandegren teaches various tasks/steps

that are performed (eg. by software program on the mobile and within the network) for

operation of the described system/invention (C3, L40-67 to C4, L1-23)

Daly teaches the ability to convey data between a cellular phone and a data

network/server which is well known in the art (title, abstract and figures 1b, 2 and 4).

The applicant cites in their specification the ICQ notification system/device

(Mirabilis, Ltd.) that allows a user to find out who are the other (arbitrary) users that are

connected to the Internet (pg. 2, L1-15). **Gutfreund** teaches collaborative software that

allows a user of the application to request a list of all (arbitrary) users known to the

collaboration software (abstract).

It would have been obvious to one skilled in the art at the time of the invention to modify Sandegren, such that status can be determined from arbitrary users via a data network, to provide means for the user to gather status from other users within ANY wired/wireless network (other than those in his/her list).

As per **claim 14**, Sandegren teaches claim 4 **but is silent on** the mobile terminal of the user and the at least first information terminal automatically connect if within a predetermined communication range.

The examiner notes that the applicant's specification teaches both SUN Microsystem's JINI and Microsoft's Universal Plug and Play as technology that supports such operations (page 16, L17 to page 17, L8 of specification).

It would have been obvious to one skilled in the art at the time of the invention to modify Sandegren, such that auto-connect is established in a predetermined range, to provide automatic notification when two devices are near each other.

As per **claims 15 and 17**, Sandegren teaches claim 4 wherein the user status generating device of the first information terminal determines the identity of the user according to a password or a user name input by the user when booting the first information terminal (figures 1a-1c shows names that are used for identity. Use of passwords for identification purposes are known in the art).

As per **claim 16**, Sandegren teaches claim 4 wherein the mobile terminal/information terminal connect via wire or wirelessly (title teaches "wireless" which is an RF electronic communications channel AND figure 2a shows both wireless and wired communications links being used, #209 and #211/#215).

As per **claims 18 and 22**, Sandegren teaches claim 4 wherein a plurality of mobile terminals are in communication with the at least one first information terminal and the user status generating device of the at least one first terminal determines the user identity and status of each mobile user and transmits the determined user identity and status to each respective user mobile (figures 1a-1c show a user and several other users that are notified).

As per **claims 19 and 21**, Sandegren teaches claim 4 wherein wherein the user status is determined by an executing application and the user status comprises at least one of email, internet phone usage, computer file usage, text editor, internet phone application and email (abstract teaches notification including online/offline, location and associated voicemail or email which reads on the claim).

As per **claim 20**, Sandegren teaches claim 4 wherein the user status generating device is a component of an executing application by the user in the first terminal and the user status is determined by the application component according to a status of the executing application (figure 2c shows an application that runs on mobile devices/phones and figures 3a-3e show status that can be determined/communicated by the application).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SMD
10-15-03

WILLIAM TROST
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